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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Guedalia

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EXAMINER

PHAN, JOSEPH T

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

06/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/996,278	Applicant(s) GUEDALIA ET AL.	
	Examiner JOSEPH T. PHAN	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/24/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8,10,11,15,16,18,20,21,25-27,30,31,35-37 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) 21, 25-27, 30-31, 35-37, and 40-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8,10,11,15,16,18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,5,6,8,10,11,15,16,18,20,21,25-27,30,31,35-37 and 40-45.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 5, 6, 8, 10, 11, 15, 16, 18, and 20 have been considered but are not persuasive and claims 21, 25-27, 30-31, 35-37, and 40-45 are withdrawn in view of the restriction requirement below.

Applicant contends that the prior art, Frerichs does not teach 'determining if said audio stream is delayed or slowed down'. However, the examiner respectfully disagrees, as Frerichs discloses this at col.14 lines 54-67. He teaches here that the audio is 'delayed' because 'there is delay in the network'. It is noted that this also occurs in one audio stream.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1, 5, 6, 8, 10, 11, 15, 16, 18, and 20, drawn to monitoring and inserting advertisements into a live audio stream, classified in class 379, subclass 32.01.
 - II. Claims 21, 25-27, 30-31, 35-37, and 40-45, drawn to seeking and navigating a stored audio segment, classified in class 379, subclass 88.25.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because monitoring and inserting a segment into a live audio stream does not need

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navigating a stored audio segment. The subcombination has separate utility such as a user being able to navigate a stored audio message to seek out a specific portion.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

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(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with attorney of record, Paul Sorkin on 06/02/2010 a provisional election was made without traverse to prosecute the invention of I, claims 1, 5, 6, 8,

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10, 11, 15, 16, 18, and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21, 25-27, 30-31, 35-37, and 40-45 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 6, 8, 10, 11, 15, 16, 18, and 20 rejected under 35 U.S.C. 102(e) as being anticipated by Frerichs et al., Patent #6,684,249.

Regarding claims 1 and 11, Frerichs teaches a system and method for audio streaming(Fig.1), the system and method comprising:

an audio streaming server providing an audio stream(Fig.1, col.4 lines 1-18, col.6 lines 20-22), a client including a buffer storing at least portions of said audio stream received from

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said audio streaming server(Fig.2, col.7 lines 26-40, and col.13 lines 5-61), a buffer status sensor operative to monitor the contents of said buffer, and to monitor a rate of said audio stream to determine if said audio stream is delayed or slowed down(col.7 lines 25-35 and col.14 lines 54-67), said buffer status sensor including an audio sampler for sampling portions of said audio stream(col.7 lines 1-5, 30-50, and lines 62-67, and col.14 lines 54-67), said buffer status sensor identifying, as a function of said playback rate and of said audio stream rate, one or more locations in said audio stream where an audio segment could be inserted when said audio stream is delayed or slowed down (col.6 lines 23-30, col.7 lines 1-50, and col.10 lines 20-56); and

a client audio output inserter operative in response to an output from said buffer status sensor for providing a modified audio stream output including pre-recorded audio segments which were not received from said audio streaming server(col.6 lines 46-51), inserted at one or more of said audio stream locations identified by said buffer status sensor(col.6 lines 31-42, col.7 lines 41-52, and col.10 lines 20-56).

Regarding claims 5 and 15, Frerichs teaches a system and method according to claims 2 and 12 and wherein said inserted audio segments comprise advertisements (col.13 lines 48-64 and col.14 lines 54-67).

Regarding claims 6 and 16, Frerichs teaches a system and method according to claims 1 and 11 and wherein said client comprises a telephone(col.11 lines 10-12).

Regarding claims 8 and 18, Frerichs teaches a system and method according to claims 1 and 11 wherein said client comprises a telephone and an IVR(col.11 lines 6-21).

Regarding claims 10 and 20, Frerichs teaches a system and method according to claims 1 and 11 and wherein said client provides a real time output(col.7 lines 51-58).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH T. PHAN whose telephone number is (571)272-7544. The examiner can normally be reached on Mon-Fri 9am-6:30pm EST, off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph T Phan/
Primary Examiner, Art Unit 2614